



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,740	08/18/2008	Clifford Neal Prescott	100325.0251US1	3007

24392 7590 09/15/2011

FISH & ASSOCIATES, PC  
ROBERT D. FISH  
2603 Main Street  
Suite 1000  
Irvine, CA 92614-6232

EXAMINER
----------

KEE, FANNIE C

ART UNIT	PAPER NUMBER
----------	--------------

3679

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

09/15/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rfish@fishiplaw.com  
patents@fishiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,740	<b>Applicant(s)</b> PRESCOTT ET AL.	
	<b>Examiner</b> Fannie Kee	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2011 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because in Figure 1D, drawing element numbers appear to be missing to depict what is described in the specification (page 7, line 3-16).
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: drawing element “100A” (page 6, line 7).
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1 – “100”.
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet”

Art Unit: 3679

pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

5. The disclosure is objected to because of the following informalities:
    - a. All bolding and underline should be removed from the specification. The specification should not contain any formatting. See MPEP 608.01(a)(c).
    - b. The following reference characters is shown in the drawings but not mentioned in the description: Figure 1 – “100”.
    - c. Page 5, line 3 – Figure 3 does not appear to be a photograph, rather, Figure 3 appears to be a perspective view. Is this correct?
    - d. Page 6, line 8 - the following reference sign is mentioned in the description but not shown in the drawings: drawing element “100A”. (Note: page and line reference is taken from the amended paragraph filed on 3/28/11.)
    - e. Page 6, line 13 – replace “120A and 120A” with --120A` and 120A``--. (Note: page and line reference is taken from the amended paragraph filed on 3/28/11.)
- Correction is required.

***Claim Objections***

6. Claim 9 is objected to because of the following informalities: replace the word “fluidly” with --fluid-- in line 2.

Correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites “A field joint for a cryogenic pipe-in-pipe pipeline, in which an inner portion of the field joint is configured to allow fluidly coupling of a first and a second section of a product conduit of the pipeline, in which an outer portion is configured to allow coupling together of a first and a second section of a jacket of the pipeline, and in which inner and outer portions of the field joint are coupled together...” Are the inner and outer portions being coupled together the same inner and outer portions recited previously in the claim? It appears that additional inner and outer portions are being recited in claim 1. If the inner and outer portions are the same portions, Applicant should recite these portions as such. As it is not clear what Applicant is claiming, Examiner will interpret this claim as best understood.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-7 and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by McKay et al U.S. Patent No. 3,865,145.

With regard to claim 1, and as seen in Figure 7, McKay et al disclose a cryogenic pipeline comprising:

a bulkhead having an inner transition element (58), and a first and a second outer transition element (60, 60) coupled to and at least partially surrounding the inner transition element;

wherein the inner transition element forms a conduit that is configured to allow transfer of a cryogenic product from a first cryogenic pipeline (12) to a second cryogenic pipeline (12); and

wherein the first and second outer transition elements are configured to allow coupling of a first (14) and a second (14) jacket pipeline to the first and second cryogenic pipelines, respectively, such that thermal stress load in the first and second cryogenic pipelines is transferred to the first and second jacket pipelines, respectively.

Art Unit: 3679

With regard to claim 2, and as seen in Figure 7, McKay et al disclose the inner transition element (58) having a pipe configuration with an inner diameter that is substantially identical to an inner diameter of the first and second cryogenic pipelines.

With regard to claim 3, and as seen in Figure 7, McKay et al disclose at least one of the outer transition elements having an outer diameter that is substantially identical to an outer diameter of the first and second jacket pipelines.

With regard to claim 4, and as seen in Figure 7, McKay et al disclose a sleeve (66) disposed in a space between the first and second outer transition elements.

With regard to claim 5, and as seen in Figure 7, McKay et al disclose at least one of the inner transition element and the first and second cryogenic pipelines being at least partially enclosed by an insulating material (50).

With regard to claim 6, and as seen in Figure 7, McKay et al disclose an external insulation (50) that covers the first and second outer transition elements.

With regard to claim 7, and as seen in Figure 7, McKay et al disclose the inner transition element and the outer transition elements being contiguous.

Art Unit: 3679

As best understood by Examiner, with regard to claim 9, and as seen in Figure 7, McKay et al disclose a field joint for a cryogenic pipe-in-pipe pipeline, in which an inner portion (58) of the field joint is configured to allow fluidly coupling of a first (12) and a second (12) section of a product conduit of the pipeline, in which an outer portion (60) is configured to allow coupling together of a first (14) and a second (14) section of a jacket of the pipeline, and in which inner and outer portions are coupled together such that a thermal stress load from the first and a second sections of the product conduit is transferred to the first and second sections of the jacket in the pipeline, respectively.

As best understood by Examiner, with regard to claim 10, and as seen in Figure 7, McKay et al disclose the outer portion being separated into two ring-shaped elements (60, 60) that are coupled to the inner portion via an angled connector.

As best understood by Examiner, with regard to claim 11, and as seen in Figure 7, McKay et al disclose a sleeve (66) being disposed in a space between the two ring-shaped elements.

As best understood by Examiner, with regard to claim 12, and as seen in Figure 7, McKay et al disclose insulating material (50) coupled to at least one of the product conduit and the inner portion.

Art Unit: 3679

As best understood by Examiner, with regard to claim 13, and as seen in Figure 7, McKay et al disclose insulating material (50) that covers the outer portion to form an external insulation.

As best understood by Examiner, with regard to claim 14, and as seen in Figure 7, McKay et al disclose the inner and outer portions being configured to form a single piece.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over McKay et al.

With regard to claim 8, McKay et al disclose the claimed invention but do not disclose that a weight coating coupled to at least one of the first and second jacket pipelines. Weight coatings are applied to pipelines to provide negative buoyancy and mechanical protection.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied a weight coating to at least one of the first and second jacket pipelines because weight coatings are applied to pipelines to provide negative buoyancy and mechanical protection.

***Response to Arguments***

13. Applicant's arguments filed 4/21/11 have been fully considered but they are not persuasive.

f. Applicant argues that McKay et al disclose a device which is a stress cone that is externally applied to pipeline sections and that there is no thermal stress load which can be transferred from the pipeline to the jacket pipeline.

Examiner disagrees.

Applicant appears to be arguing the function of the invention rather than the structure of the invention. Also, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Further, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all of the structural limitations of the claim. As McKay et al disclose the structural limitations of the claim, McKay et al is capable of performing the function.

g. Applicant argues that McKay et al do not disclose an inner transition element that forms a conduit that is configured to allow transfer of a cryogenic product from a first cryogenic pipeline to a second cryogenic pipeline as McKay et al use an externally applied stress cone.

Examiner disagrees.

Art Unit: 3679

As discussed in paragraph 10 above, McKay et al disclose an inner transition element (58) that forms a conduit that is configured to allow transfer of a cryogenic product from a first cryogenic pipeline to a second cryogenic pipeline. It has also been held that the recitation that an element is “configured to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. It is not clear what Applicant is arguing with regard to the fact that McKay et al use an externally applied stress cone. The structure of McKay et al meets the limitations as recited in the claims, therefore, McKay et al anticipates the invention recited in the claims.

h. Applicant argues that McKay et al do not disclose claim 9 which requires that an inner portion of the field joint be configured to allow fluid coupling of a first and a second section of a product conduit of the pipeline.

Examiner disagrees.

As discussed in paragraph 10 above, McKay et al disclose an inner portion of the field joint (58) that is configured to allow fluid coupling of a first and a second section of a product conduit of the pipeline. It has also been held that the recitation that an element is “configured to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fannie Kee whose telephone number is (571)272-1820. The examiner can normally be reached on 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3679

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AARON DUNWOODY/  
Primary Examiner, Art Unit 3679

/F. K./  
Examiner, Art Unit 3679  
September 9, 2011